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IN THE

Supreme Court of the United States

OCTOBER TERM, 1958.

No. 340

THE DIVERSEY CORPORATION,
Petitioner,

vs.

CHARLES PFIZER & CO., INC.,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

CHARLES J. MERRIAM,
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THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1958.

No. ....

THE DIVERSEY CORPORATION,

Petitioner,

vs.

CHARLES PFIZER & CO., INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI.

To the Hon. Chief Justice and Associate Justices of the Supreme Court of the United States:

The Diversey Corporation prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals of the Seventh Circuit entered in the above case on May 9, 1958.

OPINIONS BELOW.

The District Court gave no opinion. The Findings of Fact and Conclusions of Law were not reported but are included in the record (Joint App. pp. 475-484; 516-517). The opinion of the Court of Appeals is reported 255 F. 2d 60.

JURISDICTION.

The judgment of the Court of Appeals was entered May 9, 1958. A Petition for Rehearing was denied on June 10, 1958. Jurisdiction of this court was invoked under 28 U. S. C. 1254(1).

QUESTIONS PRESENTED.

(1) Is civil entrapment by which infringment of a patent is procured, but where the person entrapped does nothing different than he would have done in any event, constitute such unclean hands as to require dismissal of an infringement action.

(2) Is a Court of Appeals required to consider the opinion of an expert witness as "substantial evidence" which bars it from reviewing a Conclusion of Law as to validity of a patent under Rules of Civil Procedure 52(a).

STATEMENT OF THE CASE.

This is a suit for patent infringement of patent No. 2,615,846 owned by Petitioner, relating to the use of a chemical called sodium gluconate in hot caustic alkali (lye) for bottle washing.

Petitioner had unprovable indications of wide-spread infringement by Respondent. It entrapped Respondent into a particular infringement in Illinois. The salesman of Respondent who made the sale testified that he made no statements different than he would have made to anyone else. (Joint App. 295.) The District Court found that this entrapment barred Petitioner from relief.

The District Court also found the patent invalid based upon the opinion testimony of Respondent's expert, Dr. Martell who said at pages 316 and 321 of the joint appendix to the record that the prior art now taught him

the substance of the invention. The District Court in Finding 12 (Joint App. 478) specifically gave these citations as the basis for his ruling that the prior art taught the essentials of the patent. The Court of Appeals in its opinion (appendix to this brief, p. 11) held that it could not consider overturning the finding of fact as to what the art taught or the Conclusion of Law as to invalidity of the patent because of Rule 52(a).

There was much testimony in the case to the contrary.

REASONS FOR ALLOWANCE OF THE WRIT.

Petitioner realizes the reluctance of this Court to undertake a reconsideration of a technical patent suit and is not attempting to procure such a reconsideration in the usual sense.

The two questions presented do not require any consideration of the technical subject matter of the patent but merely present two questions of law upon which this Court should pass.

The first of these questions, that of civil entrapment, is one upon which no court other than the courts below have directly passed upon. However, it was indirectly passed upon in *Metal Tool Service* v. *National Tool Co.* 103 F. 2d 581, at 584 (CA6) and the decision of the courts below is contrary to the dictum of the *National Tool* case. In view of the severe penalties inflicted upon Petitioner for which there was no previous indication even hinting that such conduct was wrong, a decision by this Court is called for. It is not one which presents technical problems or a consideration of technical questions.

The second question presented is one relating to the power of the Court of Appeals under Rules of Civil Procedure No. 52(a).

The District Court had entered a finding No. 12 that the

patent in suit taught nothing essential over the prior art (Joint App. 478) and a Conclusion of Law that it was invalid (Joint App. 484). The Court of Appeals, in its opinion (appendix to the petition, p. 11) said:

> "There is testimony in the record that the prior art teaches that sodium gluconate in the presence of caustic soda will prevent precipitation of hard water constituents and that sodium gluconate is a good sequestering agent for a wide variety of metal compounds of metal salts, including calcium, in the presence of caustic soda.
>
> "We cannot hold that the findings of invalidity of the patent in suit over the prior art are clearly erroneous under Rule 52(a)."

The only testimony in the record supporting this point is an opinion of defendant's expert, Dr. Martell and the District Court expressly referred only to it.

We are not asking this Court to pass upon whether or not, in view of the weight of the evidence, the Court of Appeals should have adopted Dr. Martell's opinion, but we are asking that this Court indicate that the Court of Appeals did have power under Rule 52(a) to pass upon the validity of a patent and to send the case back for that consideration.

The decision of the Court of Appeals on this point is directly contrary to the opinion of this Court in *Diamond Rubber Co.* v. *Consolidated Rubber Co.*, 220 U. S. 428, at 434-5, and the decision of the Third Circuit Court of Appeals in *National Co.* v. *Belcher*, 71 Fed. 876 at 879.

We submit that in view of the indicated position of this Court that it will not normally pass upon patent questions, it is overwhelmingly important that the Courts of Appeals be required to consider the record where it is proper, as in this case, and not finally to accept a decision of the

District Court founded solely upon the opinion of an expert without being free to consider the matter itself.

Both of the points urged here were covered in the Petition for Rehearing. The Court of Appeals denied the Petition but did not in any way deny that the only evidence supporting the finding as to invalidity was the opinion of Dr. Martell.

CONCLUSION.

For the foregoing reasons, it is requested that this petition for a writ of certiorari be granted.

Respectfully submitted,

CHARLES J. MERRIAM,
SAMUEL B. SMITH,
30 West Monroe Street,
Chicago 3, Illinois,
Counsel for Petitioner.

APPENDIX.

IN THE UNITED STATES COURT OF APPEALS

for the Seventh Circuit

No. 12155. SEPTEMBER TERM 1957 - APRIL SESSION 1958

THE DIVERSEY CORPORATION,
Plaintiff-Appellant,
v.
CHARLES PFIZER AND CO., INC.,
Defendant-Appellee.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

May 9, 1958

Before FINNEGAN and PARKINSON, *Circuit Judges*, and MERCER, *District Judge*.

PARKINSON, *Circuit Judge*. The plaintiff, an Illinois corporation, hereinafter referred to as Diversey, instituted suit in the District Court for the Northern District of Illinois, Eastern Division, against the defendants Charles Pfizer and Co., Inc., a Delaware corporation, hereinafter referred to as Pfizer, and Dr. Pepper Bottling, Inc., an Illinois corporation, hereinafter referred to as Pepper.

The complaint charged both defendants with infringement in the district where filed of plaintiff's patent No. 2,615,846 and defendant Pfizer with additional infringement elsewhere.

On the day Diversey filed its complaint it also filed a

motion, with supporting affidavit of Clarence B. Jones, for leave to take the depositions of Carl E. Lanning, Connie McGrath, Frank W. Wilson and George A. Veeder within twenty days after the commencement of the action.

Twenty-two days after Diversey filed its complaint it filed an amendment dismissing the defendant Pepper.

Pfizer filed its answer in admission and denial and affirmative defenses of non-infringement, misuse and unclean hands. Subsequently, by stipulation of the parties, Pfizer was permitted to file a counterclaim for a declaratory judgment declaring Diversey's Patent No. 2,615,846 invalid, unenforceable and not infringed and seeking to enjoin Diversey from interfering with its sales of sodium gluconate.

Trial was to the court. The District Court entered its findings of fact and conclusions of law. It found and concluded that Diversey came into court with unclean hands; that the patent in suit was invalid over the prior art; that it was invalid due to double patenting; and that the alleged patent had not been infringed by Pfizer but rather had been misused by Diversey. Judgment was entered accordingly. Diversey's complaint was dismissed and Diversey was enjoined from suing or threatening to sue Pfizer or any of its customers or potential customers for infringement, due to sale or use of Pfizer's sodium gluconate or gluconic acid, of Patent No. 2,615,846, the patent in suit, and also Patent No. 2,584,017, the so called "parent patent". This appeal followed.

The District Court entered judgment, *inter alia*, dismissing Diversey's complaint because of unclean hands. This portion of the judgment was based on Conclusions of law Nos. 2 and 3 which are founded upon Findings of Fact Nos. 14, 15, 16, 17 and 18.

The unlisputed evidence is that Diversey acting

through its secretary and general counsel, Clarence B. Jones, and its vice-president in charge of sales, Bland B. Button, Jr. purposely contacted George Veeder, owner of Pepper, to induce him to infringe, within the Northern District of Illinois, the patent in suit with Pfizer as a contributory infringer. At the solicitation of Jones and Button, Veeder agreed and made contact by telephone with Pfizer and talked with a Mr. Hill. Veeder told Hill he would like to get all the information he could on the uses of sodium gluconate and that he probably would purchase some from Pfizer. Hill said he would send someone to call on Veeder and, at Veeder's request, sent Carl Lanning, a Pfizer salesman who had solicited Veeder regularly and from whom Veeder had bought citric acid.

The testimony of Veeder and Lanning is in conflict as to whether Pfizer was a contributory factor in the infringement. However, the uncontradicted evidence establishes that Veeder infringed the patent in suit at the specific request and solicitation of Diversey with the understanding that his company was to be joined as a co-defendant in the action to be subsequently instituted by Diversey; that he was to testify as a witness for Diversey; that he was to request Pfizer to assume Pepper's defense; and that if Pfizer refused Pepper was to be dismissed from the suit.

The motion of Diversey, supported by the affidavit of Clarence B. Jones, to take the depositions of Veeder and three other witnesses alleged that the plaintiff had been damaged by the activities of those *four* persons, one of whom was Veeder, and unless the depositions of those persons could be taken at the earliest possible date, steps would be taken by the *defendants* to prevent plaintiff from getting information possessed by them.

Diversey attempts to justify its conduct as being an innocent mistake and argues that the use of the plural,

defendants, in the motion was simply a typographical error.

The fallacy of this excuse is immediately exposed by the language of the very sentence of which the word "defendants" is a part. That sentence clearly discloses that when Diversey used the word "defendants" that is exactly what it intended to say. The allegation is that Diversey had been damaged by the activities of the four persons named therein—Lanning, McGrath, Wilson and *Veeder*—and it believed that unless the depositions of those four persons could be taken at the earliest possible date, steps would be taken by the defendants to inhibit the plaintiff. That allegation was absolutely false. There are only two defendants, Pfizer and Pepper. The plaintiff had not been damaged by Pepper. The uncontradicted evidence was unequivocally to the contrary. Pepper infringed at the solicitation and request of Diversey. Pepper did what it did working hand in hand with Diversey. It was to be dismissed as a defendant, if Pfizer would not assume its defense, and was to receive free engineering advice from Diversey with the further expectation of a gratuitous year's supply of Diversey's washing materials.

A court of equity will not entertain the suit of one who by deceit or any unfair means has gained an advantage as plaintiff has here. To aid this plaintiff would make the court an abettor of inequity. *Bein* v. *Heath*, 1848, 47 U. S. 241, 261; *Precision Instrument Mfg. Co.* v. *Automotive Maintenance Machinery Co.*, 1945, 324 U. S. 806, 814-815.

It is obvious from this record that the conduct of Diversey was wilful and morally reprehensible. The District Court was justified in finding, as it did, that Diversey was guilty of unclean hands and in dismissing the complaint for that reason.

The contention of Diversey that Pfizer should have

pleaded lack of venue and not counterclaimed if Pepper had not infringed is without merit. If the patent in suit was valid Pepper had infringed within the district in which the action was instituted. Pepper did so at the behest of Diversey and the failure of Pfizer to plead lack of venue could, under no circumstances, cleanse the hands of Diversey.

The trial court concluded that the patent in suit was invalid and entered a declaratory judgment accordingly. This conclusion of law correctly followed from Finding No. 12 that prior art patents and publications therein enumerated taught those skilled in the art all essential features of the patent in suit.

These patents and publications were in evidence. They were explained by expert witnesses and evidence was introduced by both parties on the subject of prior art. The expert testimony was in conflict. There is, however, ample evidence from which the trial court could find that the patent in suit was invalid over the prior art.

The patent in suit teaches that sodium gluconate prevents calcium precipitation from hard water in the presence of caustic alkali. There is testimony in the record that the prior art teaches that sodium gluconate in the presence of caustic soda will prevent precipitation of hard water constituents and that sodium gluconate is a good sequestering agent for a wide variety of metal compounds or metal salts, including calcium, in the presence of caustic soda.

We cannot hold that the findings of invalidity of the patent in suit over the prior art are clearly erroneous under Rule 52(a) of the Federal Rules of Civil Procedure, 28 U. S. C. A. *Graver Tank & Mfg. Co., Inc.* v. *Linde Air Products Co.*, 1949, 336 U. S. 271, 274-275.

Having concluded that we must accept and are bound

by the findings of the District Court that the patent in suit is invalid in view of the prior art the infringement issue requires no determination here. An invalid patent cannot be infringed. *Cummings* v. *Moore*, 10 Cir., 1953, 202 F. 2d 145, 147; *Simmons Company* v. *A. Brandwein & Co.*, 7 Cir., 1957, 250 F. 2d 440, 447.

The judgment from which this appeal was taken included an injunction permanently restraining Diversey from suing or threatening to sue Pfizer or any of its customers or potential customers for infringement of Patent No. 2,615,846, the patent in suit, and also Patent No. 2,584,017, the parent patent.

The patent in suit being invalid no necessity exists for an injunction restraining Diversey from suing or threatening to sue for its infringement.

Patent No. 2,584,017 was not in issue under the pleadings in this case. Although we realize that we can consider the pleadings amended under some circumstances, we decline to do so on the record here. Accordingly paragraph 7 of the judgment was erroneously entered.

Therefore, as to paragraph 7 the judgment is reversed. In all other particulars the judgment is affirmed.

JUDGMENT.

UNITED STATES COURT OF APPEALS

For the Seventh Circuit,

Chicago, 10, Illinois.

May 9, 1958.

Before:

Hon. Philip J. Finnegan, Circuit Judge.
Hon. Lynn Parkinson, Circuit Judge.
Hon. Frederick O. Mercer, District Judge.

The Diversey Corporation, *Plaintiff-Appellant,* vs. Charles Pfizer & Co., Inc., *Defendant-Appellee,*	Appeal from the United States District Court for the District of Eastern Division.
No. 12155	

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Illinois, Eastern Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, reversed as to paragraph 7 thereof, and in all other particulars, the said judgment of the said District Court is hereby affirmed with costs.

UNITED STATES COURT OF APPEALS

For the Seventh Circuit,

Chicago 10, Illinois.

June 10, 1958.

Before:

Hon. Philip J. Finnegan, Circuit Judge.
Hon. W. Lynn Parkinson, Circuit Judge.
Hon. Frederick O. Mercer, District Judge.

The Diversey Corporation,
Plaintiff-Appellant,
vs.
Charles Pfizer & Co., Inc.,
Defendant-Appellee.
} No. 12155.

On consideration of the petition of plaintiff-appellant for rehearing together with six page brief of defendant-appellee in opposition thereto concluding that "[p]laintiff has shown no ground for rehearing. Its petition is without merit and should be denied.", and

On consideration of the petition of defendant-appellee for rehearing together with nine page answer of plaintiff-appellant in opposition thereto with prayer that the petition "be denied as having no sound basis in law.",

It Is Ordered that rehearing be and is hereby denied.

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BRIEF IN RESPONSE TO PETITION

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JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

October Term, 1958.

No. 340.

THE DIVERSEY CORPORATION,
Petitioner,

v.

CHAS. PFIZER & CO., INC.,
Respondent.

Brief in Response to Petition.

ARTHUR G. CONNOLLY,
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WERNER H. HUTZ,
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WILLIAM J. MARSHALL, JR.,
Of Counsel for Respondent.

October 6, 1958.

International, 711 So. 50th St., Phila. 43, Pa.

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1958

No. 340

THE DIVERSEY CORPORATION,
Petitioner,

v.

CHAS. PFIZER & CO., INC.,[1]
Respondent.

BRIEF IN RESPONSE TO PETITION.

STATEMENT BY RESPONDENT.

This petition should be considered in connection with Pfizer's own petition, No. 344 October Term, 1958.[2] If that petition is granted, Pfizer does not oppose the granting of Diversey's petition, provided the questions presented by it are restated as hereinafter set forth to conform to the record of this case. Otherwise, Pfizer opposes the granting of Diversey's petition because the questions as stated by Diversey are not raised by this case and their determination would be of no help to the parties or the public.

---

1. This is Pfizer's correct corporate name, rather than as shown in the Diversey petition.

2. To avoid confusion, in view of the cross-petitions, the parties will be referred to herein as "Pfizer" and "Diversey".

OPINIONS BELOW.

The district court filed no opinion as such. The findings of fact and conclusions of law of the district court (J. A.[3] 475; Appendix B to Pfizer petition, page 2a) are unreported. The opinion of the court of appeals (Appendix to Diversey petition, page 7) is reported in 255 F. 2d 60.

JURISDICTION.

The judgment of the court of appeals was entered on May 9, 1958. Timely petitions for rehearing were filed by both parties on May 24, 1958, each of which was denied on June 10, 1958. Jurisdiction of this Court is properly invoked under 28 U. S. C. § 1254(1).

COUNTER-STATEMENT OF THE QUESTIONS PRESENTED.

1. Is it unclean hands, requiring dismissal of a patent infringement action, for the patent owner—

(a) To attempt to establish contributory infringement, or active inducement of infringement, of its so-called "use patent" within the jurisdiction of the district court, by arranging secretly for a friendly third party to purchase the staple commodity involved from a competitor of the patent owner and use it in the manner called for by the patent;

(b) To join the friendly third party as a sham defendant and instigate a request by it to the real defendant to assume its defense, with the understanding that if the real defendant refused to do so the sham defendant would be dropped from the action; and

3. Refers to Joint Appendix before the court of appeals.

(c) To intentionally mislead the court by filing with the complaint a motion and supporting affidavit knowingly making false representations that the sham defendant was hostile to the patent owner and would destroy or conceal the evidence of the purported infringement?

2. What quantum of evidence is required under F. R. C. P. 52(a) to support findings of fact by a district judge sitting without a jury that the supposed invention of a patent is fully taught by the prior art and that any differences are so slight that they are without patentable significance, i.e., that they were merely obvious?

COUNTER-STATEMENT OF THE CASE.

Diversey does not contend in its petition that any of the findings of fact made by the district court and affirmed by the court of appeals are clearly erroneous. Indeed, it specifically states that it does not ask this Court to pass on the weight of the evidence, and it emphasizes that its two questions "merely present two questions of law upon which this Court should pass" (Diversey petition, pages 3, 4).

The two questions posed by Diversey are not based upon the record of this case, and they were not before either of the courts below. This is apparent from a consideration of the findings of fact upon which both of the courts below bottomed their holdings of unclean hands and invalidity.

On the issue of unclean hands, the district court found the following facts (J. A. 479-81; Appendix B to Pfizer petition, pages 5a-8a):

> "14. In an effort to establish infringement of the patent in suit within the jurisdiction of this court, plaintiff through its secretary and general counsel, one Jones, and its sales manager, one Button, induced one Veeder, owner of the Dr. Pepper Bottling, Inc., of Waukegan, Illinois, to purchase sodium gluconate from

defendant and to use this product in his bottle washing operations in the manner called for by the patent in suit (R. 692-702). Veeder also consented to plaintiff's proposal to join him as a co-defendant in this suit, and agreed to give his deposition for the purpose of establishing jurisdiction of this court and infringement of the patent in suit. Plaintiff was to bear any expense Veeder incurred in this case if Pfizer did not assume his defense (R. 700-2). In return for this cooperation, Veeder expected to receive a year's supply of washing materials free of charge from plaintiff (R. 716-18).

"15. Pursuant to his agreement with plaintiff, Veeder had a meeting on August 9, 1955, with Carl Lanning, one of defendant's salesmen. At this meeting Veeder ordered 100 pounds of Pfizer's sodium gluconate (R. 671). He also questioned Lanning about the uses of the materials and the strength of plaintiff's patents in an endeavor to obtain information which might be of value to plaintiff in this suit. Upon receipt of the sodium gluconate, Veeder caused it to be used in the manner called for by the patent in suit (R. 702). Veeder fully informed plaintiff's secretary and general counsel and its patent counsel of his meeting with Lanning and the manner in which he had employed defendant's sodium gluconate to infringe the patent in suit (R. 714-15, 724-26).

"16. On the basis of the information supplied by Veeder, plaintiff's general counsel and its patent counsel caused the present action to be filed on September 6, 1955, joining Veeder's company as a co-defendant with Pfizer. Before this suit was begun plaintiff forwarded to Veeder a copy of the complaint and of the motion and affidavit which was to be filed with it (R. 724, 731). The complaint charged that Veeder's company was an infringer of the patent in suit, although plaintiff knew that Veeder had never used sodium gluconate for bottle

washing until plaintiff arranged with him to infringe its patent (R. 680, 706). Veeder was an agent of plaintiff when he purchased sodium gluconate from Pfizer and used it to infringe plaintiff's patent.

"17. At the same time as the complaint in this suit was filed, plaintiff filed a motion for leave to take forthwith the depositions of Veeder and certain other individuals (Def. Ex. 11). This motion was supported by an affidavit of said Jones, plaintiff's secretary and general counsel. The motion and affidavit represented to this court that Veeder's company had infringed the patent in suit, that Veeder was hostile to plaintiff, and that he would destroy the evidence of infringement unless plaintiff was permitted to take his deposition immediately. These allegations were false and were known by plaintiff and its attorneys to be false at the time the motion and affidavit were filed, but nevertheless they were made intentionally for the purpose of misleading this court (R. 834-38, 842-45). At the time these representations were made to this court Veeder had supplied plaintiff with the evidence referred to in the motion and affidavit (R. 714, 737-44). In reliance upon the foregoing false representations this court entered an order the day this action was commenced permitting plaintiff to proceed forthwith to take the depositions of said Veeder and certain other specified individuals, and said depositions were taken thereafter pursuant to said order.

"18. After this action was commenced, Veeder requested Pfizer to assume his defense in this case, and when Pfizer refused to do so he informed plaintiff of this fact. Thereafter, plaintiff amended the complaint to dismiss Veeder as a co-defendant, in accordance with the understanding between them (R. 697, 727-28). Plaintiff sought to conceal from Pfizer and this court

the arrangement which it had entered into with Veeder and the relationship which existed between them."

Based on these findings of fact, the district court made the following conclusions of law (J. A. 483; Appendix B to Pfizer petition, page 10a):

"2. Plaintiff's arrangement with one Veeder, for the purpose of infringing the patent in suit and giving this court jurisdiction over the action, constitutes unclean hands which require a dismissal of the complaint.

"3. The false representations which plaintiff made to this court on its motion and affidavit, filed with its complaint herein, constitute unclean hands which require a dismissal of the complaint."

These findings of fact and conclusions of law were reviewed and affirmed by the court of appeals (Appendix to Diversey petition, pages 12, 13), which added its opinion (Appendix to Diversey petition, page 10):

"It is obvious from this record that the conduct of Diversey was wilful and morally reprehensible. The District Court was justified in finding, as it did, that Diversey was guilty of unclean hands and in dismissing the complaint for that reason."

On the issue of validity, the trial court heard a great deal of both factual and opinion testimony. The factual testimony concerned such matters as errors and inconsistencies in Diversey's representations to the Patent Office during the prosecution of its patent, experiments conducted to duplicate the prior art, the meaning and significance of technical terms, etc. Thus, the finding of invalidity was based on much more than "the opinion of an expert witness", as stated in Diversey's question.

Based on the evidence referred to above, the district court found the following facts (J. A. 478; Appendix B to Pfizer petition, page 5a):

"12. Prior to the invention of the patent in suit, it was well known in the art that sodium gluconate was a good sequestering agent in alkaline solution for a large number of metal salts, including copper, iron, aluminum, chromium, calcium, magnesium, zinc and cadmium. This is taught by the following prior art patents and publications (Def. Ex. 2 and 18, Tabs 4-8):

Chester U. S. Patent 2,145,827, issued January 31, 1939;

Industrial & Engineering Chemistry, August, 1940 (Def. Ex. 2);

The Condensed Chemical Dictionary, 3rd Edition, 1942;

French Patent 885,521, issued May 31, 1943; and

McDonald U. S. Patent 2,362,284, issued November 7, 1944.

These prior art patents and publications teach those skilled in the art all essential features of the patent in suit (R. 1356-57, 1368)."

Based on this finding, the district court made the conclusion of law that the patent in suit is invalid (J. A. 484; Appendix B to Pfizer petition, page 10a).

The court of appeals affirmed as to these matters (Appendix to Diversey petition, page 13) and stated in its opinion (Appendix to Diversey petition, page 11):

"The trial court concluded that the patent in suit was invalid and entered a declaratory judgment accordingly. This conclusion of law correctly followed from Finding No. 12 that prior art patents and publications therein enumerated taught those skilled in the art all essential features of the patent in suit.

"These patents and publications were in evidence. They were explained by expert witnesses and evidence was introduced by both parties on the subject of prior

art. The expert testimony was in conflict. There is, however, ample evidence from which the trial court could find that the patent in suit was invalid over the prior art.

"The patent in suit teaches that sodium gluconate prevents calcium precipitation from hard water in the presence of caustic alkali. There is testimony in the record that the prior art teaches that sodium gluconate in the presence of caustic soda will prevent precipitation of hard water constituents and that sodium gluconate is a good sequestering agent for a wide variety of metal compounds or metal salts, including calcium, in the presence of caustic soda.

"We cannot hold that the findings of invalidity of the patent in suit over the prior art are clearly erroneous under Rule 52(a) of the Federal Rules of Civil Procedure, 28 U. S. C. A. *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 1949, 336 U. S. 271, 274-275."

ARGUMENT.

While we agree that Diversey's questions as restated by us should be considered by this Court, we do so only on the assumption that this Court also will grant Pfizer's petition and consider at the same time the questions therein presented—which are of great interest to the public as well as the parties.

If Pfizer's petition is to be denied, then we oppose the granting of Diversey's petition because the questions presented are strangers to this record—and their determination would be of academic interest only.

CONCLUSION.

For the foregoing reasons, both Diversey's petition and Pfizer's petition should be granted, with the questions presented by Diversey restated in the manner previously mentioned to conform to the record.

Respectfully submitted,

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October 6, 1958.